

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application No.: 10/782,964

Art Unit: 2173

Filed: 02/23/2004

Confirmation No.: 7566

Applicant: Andrew Bocking

Examiner: Namitha Pillai

Title: WIRELESS COMMUNICATIONS DEVICE USER INTERFACE

Docket No.: 16813-4US

Customer No.: 020988

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MS AF

Commissioner of Patents

P.O. Box 1450

Alexandria, V.A. 22313-1450

Dear Sir/Madam:

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Please find enclosed herewith form PTO/SB/33 for the pre-appeal brief request for review. Please consider below the reasons for which the review has been requested.

A Notice of Appeal is being filed concurrently.

### **REMARKS/ARGUMENTS**

In the Final Office Action dated June 5, 2009, the Examiner rejects claims 1, 2, 4-13, 15, 16, and 18-24 under 35 U.S.C. § 103(a) as being obvious in view of U.S. Patent No. 6,049,796 to Siitonen et al. (“Siitonen”) in view of U.S. Patent No. 6,950,988 to Hawkins et al. (“Hawkins”) in view of U.S. Publication No. 2004/0155908 to Wagner (“Wagner”) and further in view of U.S. Patent No. 7,295,852 to Davis et al. (“Davis”). Applicant respectfully submits that the rejections under 35 USC §103(a) are improper and requests that they be withdrawn for the reason that cited references do not teach or suggest all of the features recited in the independent claims.

It is well settled law that in order to make a prima facie case under section 103, the Examiner’s burden includes (but is not limited to) citing references that teach or suggest all of the features of the claimed invention. . *E.g., In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995); *In re Wada and Murphy*, Appeal No. 2007-3733, slip op. at 7 (BPAI 2008). If the references fail to teach or suggest one or more elements, the Examiner’s prima facie case is flawed for failing to meet this legal standard.

The Examiner has failed to make a prima facie case in which all of the claim elements have been shown. In particular, none of the cited references disclose the component to compose a destination being invokable from the home screen component **manually** by activating a communication application icon **and automatically** in response to an input from the first input device of a portion of the destination. Therefore, Applicant submits that the Examiner’s rejections constitute clear reversible legal error and that the rejections are deficient to the extent that the rejections should be withdrawn on this basis without the need for an appeal brief.

#### **The References Do Not Disclose All of the Features of Applicant’s Claims.**

The cited references do not disclose the component to compose a destination being invokable from the home screen component **manually** by activating a

communication application icon **and automatically** in response to an input from the first input device of a portion of the destination.

Claim 1 of the present application recites that the composition screen can be invoked in a combination of ways. Specifically, claim 1 recites that the component to compose a destination being invocable from the home screen component manually by activating a communication application icon **and** automatically in response to an input from the first input device of a portion of the destination. None of the cited references teach this combination.

As stated by the Examiner on page 3 of the Office Action, “Siitonen does not disclose that the user interface comprises a home screen component from which to invoke a feature from among a plurality of features provided by the device and where in the component to compose a destination is invocable from the home screen component automatically in response to an input from the key-based input device of a portion of the destination.” As further stated by the Examiner on page 5 of the Office Action, “Siitonen, Hawkins and Wagner do not disclose that the component to compose the destination is invocable from the home screen component manually by activating a communication application icon.” Thus, by the Examiner’s own admission, none of Siitonen, Hawkins and Wagner disclose the feature wherein the component to compose a destination is invocable from the home screen component manually by activating a communication application icon **and** automatically in response to an input from the first input device of a portion of the destination as recited in claim 1 of the present application.

On page 5 of the Office Action, the Examiner states that Davis discloses that the component to compose the destination is invocable from a home screen component manually by activating a communication application icon (column 6, lines 47-55). However, Davis does not teach or suggest the combination taught in the current application, namely a component to compose a destination which is invocable from the home screen component manually by activating a communication application icon **and**

automatically in response to an input from the first input device of a portion of the destination.

Therefore, the cited references fail to teach or suggest all of the features recited in claim 1 of the current application, namely a component to compose a destination which is invokable from the home screen component manually by activating a communication application icon and automatically in response to an input from the first input device of a portion of the destination.

Thus, with proper consideration of the language of the claims, Siitonen, Hawkins, Wagner and Davis, whether taken alone or in combination, do not teach or suggest the subject matter recited by the present claims.

### **Hindsight is not permitted**

Applicant also respectfully emphasizes that determinations of obviousness are not to be based on hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention, as noted in, for example, *ATD Corp. v. Lydall, Inc.*, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998).

The suggestion to combine becomes less plausible when the necessary elements can only be found in a large number of references. It is impermissible to use the inventor's disclosure as a "road map" for selecting and combining prior art disclosures. In *Interconnect Planning Corp. v. Feil* (1985), the Federal Circuit noted that "The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time." In *In re Fritch* (1992), the Federal Circuit noted:

"[I]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. ... This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.'"

**Conclusion**

In view of the above, it is submitted that the claimed subject matter includes features that are neither taught nor suggested by Siitonen, Hawkins, Wagner and/or Davis and that amended claim 1 is not obvious in view of Siitonen, Hawkins, Wagner and/or Davis. Independent claims 12 and 24 recite similar features and are patentable over Siitonen, Hawkins, Wagner and/or Davis for the same reasons. Dependent claims 2, 4-11 and 13, and 15-23 depend, either directly or indirectly, from claims 1 or 12 and are patentable for the same reasons. Therefore, it is submitted that the Examiner's rejections under 35 USC §103(a) constitute clear, reversible legal error. Applicant respectfully requests that the rejections be withdrawn.

Respectfully submitted,

**OGILVY RENAULT LLP**

Date: July 30, 2009

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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

16813-4US

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on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Application Number

10/782,964

Filed

02/23/2004

First Named Inventor

BOCKING, Andrew

Art Unit

2173

Examiner

PILLAI, Namitha

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/ss/

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

Signature

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July 30, 2009

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below.

☒ \*Total of 1 forms are submitted.

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